

Applicant : Bradley et al.  
Serial No. : 09/839,658  
Filed : April 19, 2001  
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Attorney's Docket No.: 11635-004001 / OTA 00-51

## REMARKS

### Status of the Claims

#### *Pending claims*

Claims 1 to 66 as filed are pending.

### The Restriction Requirement

The Patent Office has alleged that the pending claims of the application are directed to six separate and distinct inventions under 35 U.S.C. §121:

- I. Claims 1-17 drawn to a method for generating molecular profile of genomic DNA by hybridization, classified in class 435, subclass 6.
- II. Claims 18-27, drawn to a composition comprising fragments of genomic nucleic acids, classified in class 536, subclass 23.1.
- III. Claims 28-39, drawn to nucleic acid hybridization in the presence of antioxidant, classified in class 435, subclass 6.
- IV. Claims 40-50, drawn to a composition and a kit comprising labeled nucleic acid and antioxidant, classified in class 435, subclass 810.
- V. Claims 54-60, drawn to a method of hybridizing nucleic acids under controlled humidity, classified in class 435, subclass 6.
- VI. Claims 61-66, drawn to a composition and a kit comprising an array in a housing, classified in class 435, subclass 287.2.

### The Election

In response to the Restriction Requirement, and in partial traverse, Applicants elect Group I, claims 1 to 17, drawn to methods for generating molecular profiles of genomic DNA by hybridization.

#### *Reasons to reconsider and withdraw restriction requirement*

Applicants respectfully request the Patent Office to reconsider and to withdraw the restriction requirement, in part, for the following reasons.

Applicants respectfully request that the Patent Office reconsider the restriction requirement and rejoin Groups III to IV because after a search directed to methods for nucleic

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acid hybridization in the presence of antioxidants it would not be an undue burden for the Patent Office also to search for compositions and kits comprising labeled nucleic acid and antioxidants.

Applicants respectfully request that the Patent Office reconsider the restriction requirement and rejoin Groups V to VI because after a search directed to methods of hybridizing nucleic acids under controlled humidity it would not be an undue burden for the Patent Office also to search for compositions and kits comprising an array in a housing, wherein the housing comprises a component to measure and control the humidity in the housing. The claims of Group VI read:

61. A composition comprising an array of immobilized nucleic acids in a housing, wherein the housing comprises a component to measure and control the humidity in the housing.

62. The composition of claim 61, wherein the housing further comprises a component to measure and control the temperature in the housing.

63. The composition of claim 62, wherein the housing further comprises a component that allows programmable or preset control of the humidity and the temperature.

64. An array of immobilized probe nucleic acids in a humidity-controlled housing, wherein the housing comprises a means to control the amount of humidity in the housing during hybridization of the probes to a target in an aqueous hybridization solution.

65. An array of immobilized probe nucleic acids in a humidity-controlled housing, wherein the housing comprises a humidifier component that can control the amount of humidity in the housing during contact of the probes to an aqueous hybridization solution.

66. A kit comprising an array of immobilized nucleic acids in a housing and printed matter, wherein the housing comprises a component to control the amount of humidity in the housing, a component to control the temperature in the housing, and a component to preset or program control of the humidity and the temperature, and the printed matter comprises instructions for presetting or programming conditions in the housing to hybridize a target to the immobilized nucleic acids of the array under

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controlled hybridization conditions that comprise fluctuation of humidity and temperature during a nucleic acid hybridization step.

Applicant believes that additional fees are required for submission of this Response. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 06-1050. Please credit any overpayment to the above-noted Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858 678 5070.

Respectfully submitted,

Date:

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